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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,200	12/19/2000	Heung-For Cheng	42390P10465	7689
8791	7590	05/21/2004	EXAMINER	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD, SEVENTH FLOOR LOS ANGELES, CA 90025			NGUYEN, MERILYN P	
			ART UNIT	PAPER NUMBER
			2171	16

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/741,200

Applicant(s)

CHENG, HEUNG-FOR

Examiner

Merilyn P Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 10 March 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input checked="" type="checkbox"/> Other: <i>Detailed Action</i>        |

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***DETAILED ACTION***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/19/2004 has been entered.

2. In response to the communication dated 04/19/2004, claims 1-19 are active in this application.

***Acknowledges***

3. Receipt is acknowledged of the following items from the Applicant:

The preliminary amendment has been acknowledged and made of record as Paper No. 15 and has been considered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-3 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (U.S. 6427164) in view of Salzfass et al. (U.S. 2002/0042815).

Regarding claims 1 and 11, Reilly disclose: A method and an apparatus for reducing network bandwidth wastage incident to sending an electronic document to a nonexistent member of a distribution list having multiple destination addresses for respective members, comprising:

a machine accessible medium having instructions encoded thereon, which when executed by the machine (col. 3, lines 61 to col. 4, lines 9, Reilly), are capable of directing the machine to perform receiving a document by a document distribution server (col. 6, lines 66 to col. 7, lines 26, Reilly);

recording in a database a document identifier and the distribution list (col. 7, lines 28-62, Reilly);

distributing the document to said members of the distribution list (col. 7, lines 28-62, Reilly);

receiving, in response to distributing to a first member of the distribution list, an error message comprising the document identifier (col. 7, lines 31-35, Reilly);

looking up the identifier in the database so as to identify the distribution list (col. 3, lines 3-10, and col. 9, lines 49-58, Reilly).

However, Reilly didn't disclose: automatically deleting the destination address for the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages. On the other hand, Salzfass disclose deleting the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages (Please see [0067], Salzfass et al.). Because Reilly

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allows updating the distribution list, thus at the time invention was made, it would have been obvious to a person of ordinary skill in the art to automatically delete member from the distribution list in the system of Reilly as taught by Salzfass. The motivation would have been to enable avoiding further error messages and network bandwidth caused by repeating the transmission of message to invalid addresses.

Regarding claim 2, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Reilly/Salzfass disclose: wherein said wastage comprises bandwidth required for: said distributing the document to the nonexistent member (col. 7, lines 28-62, Reilly);

said error message received in response to said distributing (col. 7, lines 28-62, Reilly);  
a reply by a second member of the distribution list, in response to said distributing, which is distributed to the nonexistent member; and an error message responsive to said reply (col. 8, lines 50 to col. 9, lines 10, Reilly).

Regarding claims 3 and 12, all the limitations of these claims have been noted in the rejection of claims 1 and 11, respectively. In addition, Reilly/Salzfass disclose: wherein members of the distribution list receive distributions addressed such that replies to said distributions are directed to said members of the distribution list (col. 8, lines 31-49, Reilly).

5. Claims 4-10 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (U.S. 6,427,164) in view of Salzfass et al. (U.S. 2002/004,281), and further in view of Applicant's admitted prior art.

Regarding claims 4-7 and 13-16, all the limitations of these claims have been noted in the rejection of claims 3 and 12, respectively. Reilly/Salzfass discloses a email system, however, Reilly/Salzfass is silent as to disclose a Messaging Application Programming Interface (MAPI) application includes an object-oriented programming language and having a Microsoft Outlook e-mail functionality in order to compose messages. Applicant's admitted prior art discloses MAPI (See page 2-3). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the MAPI application program use for composing and disposing in the system of Reilly as suggested by Applicant's admitted prior art. The motivation being to make it easy for users to write message application that are independent of the underlying message system and implement message features with a small amount of code. Moreover, MAPI provides a consistent interface for multiple application programs to interact with multiple messaging systems across a variety of hardware platforms.

Regarding claims 8 and 17, most of the limitations of these claims have been noted in the rejection of claims 4-7 above. It is therefore rejected as set forth above.

Regarding claims 9 and 18, all the limitations of these claims have been noted in the rejection of claims 8 and 17, respectively. In addition, the combination of Reilly/Salzfass and applicant's admitted prior art disclose receiving the error message (col. 7, lines 28-62, Reilly);

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receiving the electronic document by a distribution server which performs said distributing the electronic document (col. 6, lines 66 to col. 7, lines 26, Reilly), and looking up the identifier (col. 8, lines 15-30, Reilly).

Regarding claims 10 and 19, all the limitations of these claims have been noted in the rejection of claims 8 and 17, respectively. In addition, the combination of Reilly/Salzfass and applicant's admitted prior art disclose determining the identifier based on attributes of the electronic document, said attributes comprising a subject identifier, a sending time, and a distribution list identifier (col. 7, lines 45-62, Reilly).

### ***Response to Arguments***

6. Applicant's arguments filed on 03/31/2004 with respect to claims 1-19 have been fully considered but they are considered moot in view of the new grounds of rejection.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Delany U.S Patent No. 6,658,454 discloses electronic mail system with improved methodology for processing messages with mailing lists.

Nielsen U.S Patent No. 5,864,684 discloses method and apparatus for managing subscriptions to distribution lists.

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Tsuei U.S Patent No. 6,654,779 discloses system and method for electronic mail address management.

Williams U.S Patent No. 5,675,733 discloses statistical analysis and display of reception status of electronic messages.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Merilyn P Nguyen whose telephone number is 703-305-5177. The examiner can normally be reached on M-F: 8:30 - 5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

*MN*

MN

May 14, 2004

  
SAFET METJAHIC  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100